

Remarks

Status of the Application

In the Office Action, the Examiner rejected claims 1-8, 14-23 and 27 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,428,690 to Bacus et al. (hereinafter the "First Bacus Patent") in view of United States Patent No. 6,272,235 to Bacus et al. (hereinafter the "Second Bacus Patent"). The Examiner also rejected claims 9-13 and 24-26 under 35 U.S.C. §103(a) as being unpatentable in further view of United States Patent No. 6,498,006 to Wong et al. (hereinafter the "Wong Patent")

In the Drawings

Applicants include formalized versions of Figures 1-4 herewith.

In the Claims

Rejections under 35 U.S.C. §103(a)

The claims have been amended to clarify the subject matter of those claims and to overcome the Examiner's rejections under 35 U.S.C. §103(a).

The First Bacus Patent (No. 5,428,690) discloses an apparatus and method for automated assay of biological specimens on microscope slides, the Second Bacus Patent (No. 6,272,235) discloses constructing a virtual microscope slide, and the Wong Patent discloses treating infection using a substance which induces active pathogen replication and an anti-pathogen drug. Further, the First Bacus Patent "distinguishes the areas stained by the DAB and the areas stained by the methyl green," and the "images, one by the red filter and the other by the green filter, are used to separate the primary stained areas from the nuclear areas, and to separate the nuclear areas from other cell or field features." *See* column 9, line 67 to column 10, line 8.

Section 2143.01 of the *Manual of Patent Examining Procedure*, provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.¹

Applicants recognize that the Wong Patent recites “those values which exceeded the reactive threshold of 0.05 plus the mean optical density of the negative controls (equivalent to 4 standard deviations above the mean) are considered to be positive” in connection with ECS supernatant removed during cell harvest for the detection of HIV. Applicants submit however, that neither that recitation nor any portion of the Wong Patent teaches determining a specimen location on a slide. Therefore, Applicants submit that the Wong Patent does not teach, motivate, or suggest to select or combine the Wong Patent with either the first Bacus Patent or the Second Bacus Patent to produce the invention claimed in the Subject Application.

Section 2143.03 of the *Manual of Patent Examining Procedure*, provides:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.²

Claims 1 and 18 as amended, recite, *inter alia*, identifying a region of an image containing a specimen. Claim 27 as amended, recites, *inter alia*, identifying a region containing a tissue. Applicants submit that none of the First Bacus Patent, the Second Bacus Patent, or the Wong Patent disclose identifying a region of an image containing a specimen or a tissue region.

Thus, Applicants submit claims 1, 18, and 27 are patentable over the cited references because the cited references do not teach or suggest all of the limitations of claims 1, 18, and 27. Furthermore, claims 2-9, 11-13, 15-17, 19-26, and 28-32 are seen to be patentable because they depend from claims 1 and 18.

¹ MPEP § 2143.01, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

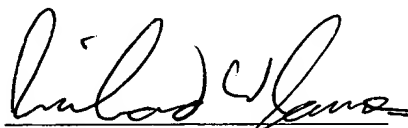
² MPEP § 2143.01, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Conclusion

Applicants respectfully submit that claims 1-9, 11-13, and 15-32 are in condition for allowance. Applicants also submit that no new matter has been introduced in the amendments presented herein. Accordingly, reconsideration of the present objections and rejections and passage to allowance of claims 1-9, 11-13, and 15-32 at an early date are earnestly solicited.

If the Examiner is of the opinion that the Subject Application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact Applicants' Attorney at the telephone number listed below so that any concerns may be expeditiously addressed.

Respectfully Submitted



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